

REMARKS

Favorable reconsideration of this application in light of the claim amendments and the following remarks is respectfully requested.

Claims 1-21 are pending in the present application. By this amendment, claim 21 is added. No new matter is involved. Support for claim 21 is found throughout the Application as originally filed, including the last two indented subparagraphs on page 6 of the main body of the specification.

In the outstanding Office Action, claims 1-20 were rejected under 35 USC § 103(a) as unpatentable over Chiba in view of Veilleux, which is respectfully traversed.

Applicants respectfully submit that the outstanding final Office Action does not provide objective factual evidence in support of its statements that Chiba discloses a number of features of the claimed invention, as explained below.

Firstly, Chiba does not disclose, in col. 2, lines 40-47, assessing quantitative physical converting constraints associated with converting the stored managed data from the source representation to the presentation representation, as claimed. All that Chiba does in col. 2, lines 40-47 is to convert image data from the image obtaining device based on a conversion form received from an operation instructing unit. There is absolutely no explicit disclosure in col. 2, lines 40-47 of making any assessment of quantitative physical converting constraints associated with converting the stored managed data from the source representation to the presentation representation. Nor has the Office Action demonstrated by objective factual evidence that Chiba inherently accomplishes this claimed feature. In this regard, Applicants note that inherency may

not be established by probabilities or possibilities. What is inherent must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir.1993). A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002).

All that col. 2, lines 40-47 discloses is that a data converting unit simply converts image data. There is no disclosure that Chiba assesses physical quantitative converting restraints associated with converting stored managed data from a source representation to the presentation, as claimed.

Nor does Chiba perform any dynamic tradeoff between the first assessment and the second (which is not even found in Chiba) assessment, which is required to serve as a basis for the claimed feature of executing the selective data conversion on a dynamic tradeoff basis between the first assessment and the second assessment. The alleged basis for Chiba performing the claimed dynamic tradeoff and for executing selective data conversion based on this dynamic tradeoff is col. 2, lines 40-60 of Chiba.

Unfortunately, all that Chiba discloses in col. 2, lines 40-60 is a simple data conversion involving an image data conversion unit that transfers image data specified by a user and instructed by the operation instruction unit to the side of the information processing device.

Clearly, there is no explicit disclosure in the relied upon portion of Chiba of performing any dynamic tradeoff between the first assessment and the second (which is not even found in Chiba) assessment, which is required to serve as a basis for the claimed feature of executing the

selective data conversion on a dynamic tradeoff basis between the first assessment and the second assessment. Moreover, the Office Action does not even attempt to explain how the relied upon portion of Chiba inherently (i.e., not just possibly and not just probably, but necessarily) discloses performing any dynamic tradeoff between the first assessment and the second (which is not even found in Chiba) assessment, which is required to serve as a basis for the claimed feature of executing the selective data conversion on a dynamic tradeoff basis between the first assessment and the second assessment. The only statement presented to explain what is done in col. 2, lines 40-60 of Chiba is that the data conversion is done automatically by the data converting unit. However, this statement clearly does not even address, let alone explain, how the relied upon portion of Chiba inherently (i.e., not just possibly and not just probably, but necessarily) discloses performing any dynamic tradeoff between the first assessment and the second (which is not even found in Chiba) assessment.

The Office Action then admits that Chiba does not explicitly disclose the selectively converting step of selectively converting the data in the source representation to the data in the destination representation based on an idiosyncratic destination profile of a destination apparatus represented by the destination representation automatically and without receiving a specification of a conversion form of the data in the destination representation from a user.

Applicants respectfully submit that Chiba does not inherently contain such a disclosure, either.

In an attempt to remedy this admitted shortcoming of Chiba, the Office Action turns to Veilleux. Unfortunately, Veilleux does not disclose the selectively converting step selectively

converts the data in the source representation to the data in the destination representation based on an idiosyncratic destination profile of a destination apparatus represented by the destination representation automatically and without receiving a specification of a conversion form of the data in the destination representation from a user. Veilleux either uses a color profile cookie generated by a client (user) or downloads a default color image that has not been color corrected or otherwise customized for the individual display devices associated with a destination client (paragraph [0105]). If Veilleux employs a destination client color cookie, it is received from the destination client (user) because it “resides with the client” (paragraph [0103]). If Veilleux does not use a color cookie, then Veilleux clearly does not employ an idiosyncratic destination profile.

Thus, Chiba does not disclose several positively recited features of claims 1 and 18, and the only one which the Office Action tries to provide by using Veilleux, is not found in either Veilleux or Chiba.

Accordingly, even if, solely for sake of argument, one of ordinary skill in the art were properly motivated to modify Chiba in view of Veilleux, the so-modified version of Chiba would not result in, suggest, or otherwise render obvious the claimed invention.

In addition, Applicants also respectfully submit that dependent claim 7 further defines over the combination of Chiba in view of Veilleux. In more detail, dependent claim 7 further clarifies that the method is executed by consulting a rule base. Thus, the claimed invention provides an optimized document management system by executing a systematic process of performing tradeoffs based on consulting a rule base (see paragraphs [0010] and [0051] of the present application).

Examiner asserts that, with respect to claim 7, Chiba in view of Veilleux discloses the method of claim 1 executed by consulting a rule base (Chiba: Item 19 in Fig. 10). Applicants respectfully disagree with this assertion because element 19 in Chiba is merely an operation instruction unit. Its operation is explained by Chiba, as follows: "[W]hen a user specifies image data to be transferred among the image data stored in the data storing unit 13 within the image reading/displaying device 10, and also specifies, for example, a data form into which the transferred data is converted, the operation instructing unit 19 within the information processing device 11 instructs the image reading/displaying device 10 to transfer the specified image data, and also instructs the data converting unit 18 to convert the transferred into the specified data form according to the specification. A user selection of image data and specification of the type of data after being converted are made via the user interface (UI) display unit 20." There is no mention of a rule base found in Chiba. In fact, a key word search of Chiba fails to find the word, "rule."

Accordingly, neither Chiba nor Veilleux teach or suggest the rule based features in dependent claim 7.

Accordingly, it is respectfully submitted independent claims 1 and 18 and each of the claims depending therefrom are allowable.

NEW CLAIM

Independent claim 21 has been added. Claim 21 includes the subject matter of claim 1 and additional features, including using an optimum procedure for printing scanned images on a

variety of output devices, and using a single button activation of a representation retrieved from the database. Applicants respectfully submit that claim 21 patentable defines over the applied art at least for reasons presented above regarding claim 1, and also because of the aforementioned features found in claim 21.

Consideration and allowance of claim 21 are respectfully requested.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Reg. No. 46,472, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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